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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,405	03/16/2004	Robert Senn	PI/5-20835C/D1	5092

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,405

Applicant(s)

SENN ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a related subgenus of insecticidal compounds of formula (A) in instant invention, does not reasonably provide enablement for using all instant compounds of formula (A) as insecticides in instant invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Because the functional groups on the core structure of formula (A) are many (note that substituent A is extremely broad having numerous heterocyclic compounds and R₂ covers numerous possibilities) and have different sizes, polarity and electronegativity, the activity of compounds of formula (A) would be questionable. The predictability in this art is high since a small change in a functional feature could result in a drastic change in activity and such a change can also result in an opposite effect or activity. To one of ordinary skill in the art, it would be a big job to determine the effect of all of the claimed structural changes. Because of this large burden (determination of which compounds would render desired results), Examiner would like to point out that Applicant would be entitled to a subgenus of what is being claimed. Examiner stresses that the subgenus created should be a group of related compounds in terms of size,

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polarity and electronegativity. Both of these factors should be heavily considered in the election of a subgenus group of compounds for the instant invention. With respect to the method claims, it would be a great burden on the Examiner to determine which compositions would be effective as an insecticide. The method claims are broad and would require a large degree of experimentation to determine which compositions would be effective insecticides.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-16, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 22 provide for the use of instant compounds in therapy, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 21, 22 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 11-16 recite a number of compounds for the instant composition which there exist no antecedent basis. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriie et al (JP 07224062; 8/22/95) and Baranowski (Materialy Sesji Naukowe Instytutu Ochrony Roslin, 1002, vol. Date 1991, 31 (1), 214-20). Moriie teaches an insecticidal composition comprising compounds of formula (A). Moriie teaches a method of controlling insects with the compounds. Moriie teaches the instant compound of formula (A) where A is 3-pyridinyl-6-chloro; X is NNO₂; and R is methyl. Also, Moriie teaches the instant compound or formula (A) where A is chloro thiazolyl; X is NNO₂; and R is methyl. Moriie does not teach the composition or method comprising abamectin. However, Baranowski teaches an insecticidal composition comprising abamectin. Baranowski teaches a method of controlling insects with the compounds. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Moriie to include the abamectin taught by Baranowski. One would have been motivated to do this since each reference have the same utility, i.e. each reference

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discloses insecticidal inventions. With respect to the method of preparation, combining and mixing actives with carriers carry no patentable significance.

Claims 1-10, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al (JP 08291171; 11/5/96) and Baranowski (Materialy Sesji Naukowej Instytutu Ochrony Roslin, 1002, vol. Date 1991, 31 (1), 214-20). Matsuo teaches an insecticidal composition comprising a compound of formula (A). Matsuo teaches a method of controlling insects with the compound. Matsuo teaches the instant compound of formula (A) where A is 3-furanyl; X is NNO_2 ; and R is methyl. Matsuo does not teach the composition or method comprising abamectin. However, Baranowski teaches an insecticidal composition comprising abamectin. Baranowski teaches a method of controlling insects with the compounds. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Matsuo to include the abamectin taught by Baranowski. One would have been motivated to do this since each reference have the same utility, i.e. each reference discloses insecticidal inventions. With respect to the method of preparation, combining and mixing actives with carriers carry no patentable significance.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton Pryor
Primary Examiner
AU 1616